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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,595	03/15/2001	Paul D. Franke	1762-001648	3937

28289 7590 01/23/2007

THE WEBB LAW FIRM, P.C.
700 KOPPERS BUILDING
436 SEVENTH AVENUE
PITTSBURGH, PA 15219

EXAMINER	
SIDDIQI, MOHAMMAD A	
ART UNIT	**PAPER NUMBER**
2154	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/809,595	FRANKE, PAUL D.	
	Examiner	Art Unit	
	Mohammad A. Siddiqi	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-164* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-164* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-158 are presented for examination. Claims 159-164 are new.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 39, 40, 43, 82, 120 and 159 – 164 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure does not provide any description of control parameter rule, for example, in order to define any rule there has to be at least one condition and one action (if-then-else).

4. Claims 1, 39, 40, 43, 82, 120 and 159 - 164 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure does not provide any description of control parameter rule, for example, in order to define any rule there has to be at least one condition and one action (if-then-else).

5. Claims 1, 39, 40, 43, 82, 120 and 159 - 164 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. "control parameter rule" critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The disclosure does not provide any description of control parameter rule, for example, in order to define any rule there has to be at least one condition and one action (if-then-else).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim Claims 1, 39, 40, 43, 82,120 and 159 -164 recites the limitation "control parameter rule" in claims 1, 39, 40, 43, 82,120 and 159 -164. There is insufficient antecedent basis for this limitation in the specification.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-158 provisionally rejected under the judicially created doctrine of double patenting over claims 1-42 of copending Application No. 09/869,513. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

10. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious

over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (Affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

12. Claims 1-158 are rejected under 35 U.S.C. 102(e) as being anticipated by Salesky et al. (6,343,313) (hereinafter Salesky).

13. As per claim 1, Salesky discloses a method for conducting at least one convention, by facilitating the exchange between at least one meeting planner client and at least one attendee client comprising the steps of:

a. receiving, from the at least one meeting planner client (col 29, lines 62-63 and col 30, lines 15-24, potential conferee), and electronically storing in convention databases at a central website server (col 9, lines 64-67, col 30, lines 15-24), at least one control parameter rule (at the time of setup keys can be specified, col 2, lines 7-15; col 9, lines 64-67) and convention content information for a plurality of conventions (record a session for later playback, col 24, lines 66-67 – col 35, lines 1-10, and col 29, lines 34-37, several meetings);

b. receiving at the central website server from the at least one attendee client a selection for convention content information of one convention from the plurality of conventions (17,15, fig 2, col 8, lines 34-41); and

c. processing the selection at the central website server by program instructions applying the at least one control parameter rule (at the time of setup keys can be specified, col 2, lines 7-15) to differentiate participation in convention activity (to determine that a client has sufficient computing resources requires processing of control parameters (at the time of setup

keys can be specified, col 2, lines 7-15; col 2, lines 66-67; col 3, lines 1-23; lines 50-58); and

d. releasing from the central website to the at least one attendee client the selected convention content information (record presentation or lecture or video-mail, 17,14, fig 2, col 7, lines 10-20; col 8, lines 34-45, server provides information that allows attendee client conferencing software to start and connect to the conference).

14. As per claim 2, Salesky discloses the at least one meeting planner client is a plurality of meeting planner clients (col 30, lines 15-24 and col 8 lines 35-45).

15. As per claim 3, Salesky discloses at least one attendee client is a plurality of attendee clients (col 8, lines 35-45).

16. As per claim 4, Salesky discloses the convention content information is cyber-based (col 8, lines 35-45, www browser).

17. As per claim 5, Salesky discloses the convention content information is one of cyber-based and venue-based (col 8, lines 34-45, www browser).

18. As per claim 6, Salesky discloses the step of storing in a relational database cross-referencing fields from the meeting planner client to allow for the holding of an unlimited number of conventions (col 29, lines 34-41 and col 30, lines 15-30).

19. As per claim 7, Salesky discloses the steps of receiving at the central website a search request from the attendee client for certain convention content information and releasing to the attendee client information satisfying the search request (17,14, fig 2, col 8, lines 34-45, server provides information that allows attendee client conferencing software to start and connect to the conference).

20. As per claim 8, Salesky discloses the steps of receiving at the central website from the attendee client information necessary to register for the convention. (col 8, lines 34-46, being told)

21. As per claim 9, Salesky discloses the step of using attendee client information to alert attendee clients of future conventions that may be of interest to them (col 8, lines 34-36, being told).

22. As per claim 10, Salesky discloses the step of receiving at the central website, from at least one exhibitor client, convention search, selection and registration information for at least one convention (col 8, lines 30-35, presenter and attendee client, conference listing).

23. As per claim 11, Salesky discloses the at least one exhibitor client is a plurality of exhibitor clients (col 8, lines 30-35, presenter and attendee client, conference listing).

24. As per claim 12, Salesky discloses the step of storing cross-referencing fields from the convention content information in a relational database to allow an unlimited number of exhibitor clients (col 29, lines 34-41 and col 30, lines 15-30).

25. As per claim 13, Salesky discloses the step of receiving at the central website server (14, fig 1) from the meeting planner client session content information (14, 17, fig 2, col 8, lines 45-54).

26. As per claim 14, Salesky discloses the steps of receiving at the central website server (14, fig 1) a request for certain client session content information from the attendee client for and releasing to the attendee client

information satisfying the search request (14, 17, fig 2, col 8, lines 45-54).

27. As per claim 15, Salesky discloses the session content information is cyber-based (col 8, line 39, www browser).

28. As per claim 16, Salesky discloses the session content information is one of cyber-based and venue-based (col 8, line 39, www browser).

29. As per claim 17, Salesky discloses the step of providing attendee client participation in the session (fig 8B, col 8, lines 55-57).

30. As per claim 18 Salesky discloses the step of receiving at the central website server (14, fig 1) a search request from the attendee client for session information and releasing to the attendee client such information. (14,17, fig 2, col 8, lines 30-35).

31. As per claim 19, Salesky discloses the step of receiving at the central website server (14, fig 1) from the attendee client information necessary to register for the session (col 8, lines 30-37, finding or being told).

32. As per claim 20, Salesky discloses step of receiving at the central website server (14, fig 1) from an exhibitor client exhibit content information including exhibit booth design and content (col 11,lines 13-18, and lines 55-59, booths are created by graphics).

33. As per claim 21, Salesky discloses the exhibit content information is cyber-based (col 8, lines 35-45, www browser).

34. As per claim 22, Salesky discloses exhibit content information is one of cyber-based and venue-based (col 8, lines 35-45, www browser).

35. As per claim 23, the claim is rejected for the same reasons as claims 1 and 20, above.

36. As per claim 24 the claim is rejected for the same reasons as claims 1 and 20, above.

37. As per claim 25, the claim is rejected for the same reasons as claims 1 and 20, above.

38. As per claim 26, the claim is rejected for the same reasons as claims 1 and 7, above.

39. As per claim 27, the claim is rejected for the same reasons as claims 1 and 20, above.

40. As per claim 28, Salesky discloses the step of receiving at the central website from the meeting planner paper presentation content information (col 7, lines 10-17, lecture).

41. As per claim 29, Salesky discloses the paper presentation content information is cyber-based (col 8, lines 35-45, www browser).

42. As per claim 30, Salesky discloses the paper presentation content information is one of either cyber-based or venue-based (col 8, lines 35-45, www browser).

43. As per claim 31, Salesky discloses the step of releasing to the attendee client paper presentation content information (col 7, lines 10-17, lecture).

44. As per claim 32, Salesky discloses the step of receiving at the central website server (14, fig 1) from the meeting planner meeting proceedings content information (col 7, lines 10-17, lecture).

45. As per claim 33, Salesky discloses the meeting proceedings content information is cyber-based (col 8, lines 35-45, www browser).

46. As per claim 34, Salesky discloses the meeting proceedings content information is one of cyber-based and venue-based (col 8, lines 35-45, www browser).

47. As per claim 35, Salesky discloses the step of releasing to the attendee client meeting proceedings content information. (col 8, lines 30-35, presenter and attendee client, conference listing)

48. As per claim 36, Salesky discloses the step of receiving at the central website server (14, fig 1) from the meeting planner cyber broadcast content information (col 7, lines 10-20).

49. As per claim 37, Salesky discloses the step of releasing to the attendee client cyber broadcast content information (col 8, lines 35-45, www

browser).

50. As per claim 38, Salesky discloses a plurality of conventions are facilitated from the central website server (14, fig 1, col 8, lines 30-40).

51. As per claim 39, the claim is rejected for the same reasons as claim 1, above. In addition Salesky discloses c) receiving at the central website server (14, fig 1) from the attendee client information necessary to register for the convention (14,17, fig 2); e) releasing from the central website server (14, fig 1) to the at least one attendee client the selected convention content information (col 8, lines 30-35).

52. As per claim 40, the claim is rejected for the same reasons as claim 1, above.

53. As per claim 41, the claim is rejected for the same reasons as claims 40 and 10, above.

54. As per claim 41, the claim is rejected for the same reasons as claims 40 and 20, above.

55. As per claims 43-81, 82-119, and 120-158, claims are rejected for the same reasons as claims 1-38, above.

159. As per claims 159 - 164, Salesky discloses at least one control parameter rule is a plurality of control parameter rules (at the time of setup keys can be specified, col 2, lines 7-15).

Response to Arguments

56. Applicant's arguments filed 10/23/2006 have been fully considered but they are not persuasive, therefore rejections to claims 1-158 is maintained.

57. Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the

claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

58. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

59. In response to applicant's argument that Salesky patent (page 39, "The Salesky patent is not related to the invention") is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, The prior Art teaches internet based computer conferencing system where presenter client can display/edit/modify presentation contents and present to the attendee clients.

60. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon

which applicant relies (i.e., website/ASP-based convention system) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

61. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., including functional descriptive material, is loaded by a meeting planner client with the intended use of providing the website/ASP-based system) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Argument: Salesky does not disclose receiving at the central website server from the at least one attendee client a selection for convention content information of one convention from the plurality of conventions.

Response: Salesky discloses receiving at the central website server from the at least one attendee client a selection for convention content

information of one convention from the plurality of conventions (17,15, fig 2, col 8, lines 34-41).

Conclusion

62. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose

telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

NATHAN J. FLYNN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MAS